123. **(new)** The methods of claims 94, 95 or 96 wherein the method comprises screening the candidate crystalline inorganic materials with a scanning detection system.

REMARKS

Following entry of this Preliminary Amendment A, claims 94-123 are pending.

Independent claims 94 and 95 are the same claims as were pending in the parent case, U.S. Serial No. 09/881,036, following Amendment D therein. The only outstanding rejection with respect to these claims in the parent case, as set forth in the Office action dated October 8, 2003, was a rejection under 35 U.S.C. §103(a) based on Kaneyoshi *et al.* (US 5644037, JP 6-103747, US 5332558) in view of Gillson (US 4422151). To advance the prosecution of the instant applications, Applicants are responding to this rejection herein. Further consideration is respectfully requested in view of the following remarks.

Rejections under 35 USC §103(a) (Kaneyoshi / Gillson)

The Office rejected claims 94 and 95 under 35 U.S.C. §103(a) as being obvious over Kaneyoshi *et al.* (US 5644037 / JP 6-103747) or Kaneyoshi *et al.* (US 5332558) in view of Gillson (US 4422151). (*See* paragraph 10 at pages 3-6 of the Office action dated October 8, 2003 in the parent application).

Applicants respectfully traverse this basis for rejection.

The Kaneyoshi *et al.* (US 5644037 / JP 6-103747) is not prior art to Applicants' invention, since the Kaneyoshi *et al.* U.S. '037 application was filed on May 2, 1995 – *after* the effective filing date of Applicants' application (October 18, 1994), and since the '037 application is not entitled to the benefit of the JP priority date for purposes of consideration as prior art under 35 USC §102(e)/103(a). *See* In re Hilmer, 149 USPQ 480 (CCPA 1966). The JP 6-103747 reference itself is also not prior art to Applicants' invention, since there is no evidence that it was published before Applicants' effective filing date, and indeed under Japanese patent law, would not have been published until *after* Applicants' effective filing date.

The Office action does not set forth a *prima facie* case of obviousness since the cited references, taken either alone or in combination do not teach or fairly suggest all of the required features of Applicants' invention, as defined by independent claims 94 and 95. In particular, the

particular, the cited references, even if *(arguendo)* considered together, do not disclose, teach or suggest crystallization on a common substrate (claims 94 and 95). Although Gillson can be said to disclose dispensing components to a common, test tube-supporting racks, there is no teaching in Gillson that any type of reaction is effected while the test tubes reside on the rack, and especially not a crystallization reaction. Also, the cited references do not disclose, teach or suggest simultaneously crystallization on a common substrate (claim 94). Notably, there is no disclosure that the crystallization experiments in Kaneyoshi *et al.* were done at the same time. Moreover, the cited references do not disclose, teach or suggest that the crystallization conditions can be independently controlled at the plurality of regions on the substrate during the crystallization step (claim 95). The Office action states that Kaneyoshi *et al.* '037 teaches (and by reference, Kaneyoshi '558 is also said to teach), that particle morphology may vary with crystallization conditions. However, there is no disclosure that the crystallization experiments in Kaneyoshi *et al.* were done by varying the crystallization conditions on a common substrate. Gillson does not make up for the deficiencies of Kaneyoshi *et al.* in this regard.

Further, a *prima facie* case of obviousness has not been established because, absent impermissible hindsight, there is no motivation *existing in the art* that would have led a person of ordinary skill to the invention defined by claims 94 or 95. The Office action does not set forth sufficient rationale as to *why* an ordinarily-skilled person would have deviated from the time-tested and well-established conventional methods for crystallization and arrive at Applicants' invention. The Office action states, in this regard, that "(o)ne of ordinary skill would have been motivated to do so to allow for ease of preparation and testing of large numbers of crystalline inorganic materials in the search for materials having desired properties (*i.e.,* desired morphology)." However, this teaching is too general, and would not have led to Applicants' *more specifically defined* invention. Moreover, the asserted rational completely ignores the luminous literature references that demonstrate the typical reluctance of a person of skill in the art against deviating from known, standard protocols. In fact, the Kaneyoshi *et al.* '558 and '037 references demonstrate that persons skilled in the art would have been biased towards effecting crystallizations using larger-volume, independent vessels and carefully-controlled crystallization conditions. (*See,* for example, Example 1 of the '558 patent (disclosing 3.3 liter and 6.6 liter solutions) and Example 1 of the '037 patent (disclosing temperature control of $\pm$ 1° C)). As such, it appears that the Office action is impermissibly relying on hindsight.

For the reasons set forth above, the above-noted basis for rejection of claims 94 and 95 should not be applied to these claims.

Independent claim 96 is also patentable over the references relied upon in the above-identified Office action, since such references do not disclose, teach or suggest crystallization on a common substrate to form candidate crystalline inorganic materials, and that such candidate crystalline inorganic materials are screened on the substrate for a morphological property.

Accordingly, independent claims 94, 95 and 96 are each in condition for allowance. Notice of the same is respectfully requested.

Applicants are paying the filing fees based on the as-amended claims pursuant to the transmittal documents submitted herewith. If necessary, the Examiner is hereby authorized to charge any fees required in connection with this application, throughout the pendency thereof, to Deposit Account No. 50-0496.

Respectfully submitted,

Date Submitted: Feb. 3, 2004

Paul A. Stone
Reg. No. 38,628

Symyx Technologies, Inc.
3100 Central Expressway
Santa Clara, CA 95051
(408) 773-4027